

REMARKS

Claims 1-11, 13-18 and 20-24 remain pending in the application.

Reconsideration of the rejections and allowance of the pending application in view of the foregoing amendments and following remarks are respectfully requested.

In the Office Action claims 1-11, 13-18, and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al., U.S. Patent No. 4,988,300 (hereinafter “Yamaguchi”) in view of Friedson, U.S. Patent No. 6,332,307. This rejection is respectfully traversed.

The Examiner takes the position that it would have been obvious to modify the device of Yamaguchi with the inflatable bladder (25) of Friedson, which the Examiner has characterized as being an expandable and contractible member.

In this regard, Applicants note that Yamaguchi appears to disclose a balance practicing machine (entitled RIDING SIMULATOR) including a seat (31) and a drive mechanism (FIG. 1, 7) that imparts a swinging motion to the seat. However, Yamaguchi does not disclose an expandable and contractible member provided on the seat, and a mechanism that automatically and repeatedly expands and contracts the expandable and contractible member.

In the Response to Arguments, the Examiner has asserted that the term “repeatedly” in claims 1 and 18 limits [sic, does not limit?] as to how or how often, and/or when the mechanism “repeatedly” expands and contracts the member. The Examiner has further asserted that the valve 26 of Friedson is “conceivably capable” of repeatedly inflating (expanding) and deflating (contracting) the bladder 25 and such interpretation of Friedson clearly meets the claimed invention in the above explanation.

Addressing the Examiner's first assertion, that the term "repeatedly" does not limit as to how or how often, and/or when the mechanism "repeatedly" expands and contracts, Applicants respectfully note that Webster's New World Dictionary of American English, Third College Edition, 1991, defines "repeated" as "said, made, done, or happening again, or again and again". As apparent from Applicants specification, "repeatedly" as used in the context of claims 1 and 18 means "happening again and again". While Applicants may agree that "repeatedly" may not indicate how or how often, and/or when the mechanism "repeatedly" expands and contracts, it does limit the operation to expanding and contracting repeatedly, i.e., again and again. The Examiner has not provided any factual evidence to support the position that it would have been obvious to repeatedly expand and contract the bladder 25 of Friedson during use with the machine of Yamaguchi. Thus, the Examiner's rejection of independent claims 1 and 18 under 35 U.S.C. § 103(a) is defective for this reason alone.

Moreover, the Examiner's position that the valve of Friedson is "conceivably capable" of repeatedly inflating (expanding) and deflating (contracting) the bladder 25 is erroneous as a matter of law. It is clear that the standard for obviousness set forth in 35 U.S.C. § 103(a) is that the subject matter as a whole would have been obvious at the time of Applicants' invention to one of ordinary skill in the art. The standard is not that it could have been obvious, and certainly not the standard used by the Examiner that it is "conceivably capable". Accordingly, the Examiner's rejection of independent claims 1 and 18 under 35 U.S.C. § 103(a) is clearly erroneous for this additional reason.

Although Applicants do not agree with the Examiner's rejection of claims 1-18 and 21-24 on this ground for the reasons noted above, nevertheless, Applicants have amended independent claims

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1 and 18 to clearly obviate the above noted ground of rejection in order to expedite prosecution of the present application. In this regard, Applicants note that Yamaguchi and Friedson fail to teach or suggest the subject matter claimed in amended claims 1 and 18. In particular, claims 1 and 18, as amended, set forth a balance practicing machine including, inter alia, a seat, a drive mechanism, an expandable and contractible member provided at a location of said seat corresponding to thighs of the user sitting on said seat, and a mechanism that automatically repeatedly expands and contracts said expandable and contractible member in alternately repeating upwardly-outwardly and downwardly-inwardly directions during operation of the drive mechanism to provide compound motion to the seat.

This amendment is fully supported by the specification, including the claims and drawings, and no prohibited new matter has been added. In particular, support for this amendment can be found at least in a paragraph [0023] of Applicants' application.

The Yamaguchi patent discloses a riding simulator. As recognized by the Examiner, the Yamaguchi device does not include "an expandable and contractible member provided at a location of thighs of the user sitting on said seat", nor a "a mechanism that automatically repeatedly expands and contracts said expandable and contractible member in a diagonal direction during operation of the drive mechanism to provide compound motion to the seat", as set forth in amended claims 1 and 18.

The Friedson patent is directed to a collapsible saddle assembly. As shown in figure 7 and as described in column 4, line 55 through column 5, line 10, the Friedson device includes a cavity 21 that may be filled so as to "accommodate a different user or equestrian application". The cavity may

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be filled with a filler material such as wool stuffing or polyurethane, or the cavity may include a bladder filled with air. Although Friedson includes an access opening 23 for inserting and removing filler (*i.e.*, expanding and contracting the cavity) or the valve 26 for filling and removing air from the bladder (*i.e.*, expanding or contracting the bladder), Friedson does not teach or suggest that the cavity could be expanded or contracted during operation of the drive mechanism to provide compound motion to the seat, much less repeatedly expanded or contracted during operation for the reasons noted above. In fact, it is likely that the cavity of Friedson could not and would not be expanded or contracted during operation of the drive mechanism since the filler material could not be removed from the cavity during movement of the device. Accordingly, the Friedson patent fails to teach or suggest a balance practicing machine including, inter alia, a seat, a drive mechanism, an expandable and contractible member provided at a location of the seat corresponding to thighs of the user sitting on the seat, and a mechanism that automatically repeatedly expands and contracts the expandable and contractible member in alternately repeating upwardly-outwardly and downwardly-inwardly directions during operation of the drive mechanism to provide compound motion to the seat, as recited in claims 1 and 18, as amended. Applicants note that the expandable and contractible movement of the member of the presently claimed embodiment can allow the user strengthening his or her thighs, as disclosed in paragraph [0023].

With regard to the limitation “automatically” in claims 1 and 18, the Examiner asserts that it is well settled that it is not an invention to broadly provided a mechanical or automatic means to replace manual activity which has accomplished the same result in view of In re Venner, 120 USPQ 192 (CCPA 1958).

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However, Applicants respectfully disagree with the above-noted Examiner's assertion because, as noted above, there is no teaching or suggestion in Friedson of even a manual repeated expansion and contraction of the valve, only that it is "conceivably capable" of such operation, which is not the standard for obviousness set forth in 35 U.S.C. § 103(a). Accordingly, since there is no teaching or suggestion of manual repeated expanding and contracting of the bladder 25 of Friedson, clearly there can be no support for the Examiner's use of the per se rule "that it is not an invention to broadly provided a mechanical or automatic means to replace manual activity which has accomplished the same result". There is no evidence of any such manual activity which has accomplished the same result, and thus no reason to further bootstrap a faulty obviousness rejection with further faulty supposed legal support.

Accordingly, even assuming, arguendo, that the teachings of Yamaguchi and Friedson could be properly combined, the Friedson patent fails to cure the deficiencies of the Yamaguchi device, and Applicants' claimed balance practicing machine would not have resulted from the combined teachings thereof.

Further, there is nothing in the cited prior art that would lead one of ordinary skill in the art to make the modification suggested by the Examiner in the rejection of claims 1 and 18 under 35 U.S.C. § 103(a) over Yamaguchi in view of Friedson. In this regard, Yamaguchi is relevant to a balance practicing machine, whereas the device of Friedson is relevant to a saddle for actual horse back riding. Thus, Yamaguchi and Friedson appear to be non-analogous art. Thus, the only reason to combine the teachings of Yamaguchi and Friedson results from a review of Applicants' disclosure and the application of impermissible hindsight. Accordingly, the rejection of claims 1 and 18 under

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35 U.S.C. § 103(a) over Yamaguchi in view of Friedson is improper for all the above reasons and withdrawal thereof is respectfully requested.

Independent claims 1 and 18 are now in condition for allowance in view of the amendments and the above-noted remarks. Dependent claims 2-11, 13-17, and 20-24 are also submitted to be in condition for allowance in view of their dependence from the allowable base claims and also at least based upon their recitations of additional features of the present invention. It is respectfully requested, therefore, that the rejection under 35 U.S.C. 103(a) be withdrawn and that an early indication of the allowance thereof be given.

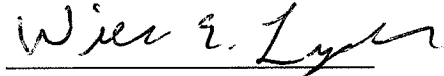
Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based on prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to be attached thereto.

Based on the above, it is respectfully submitted that this application is now in condition for allowance, and a Notice of Allowance is respectfully requested.

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Should the Examiner have any questions or comments regarding this response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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